



JPW

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Isamu TAKAHARA et al.

Group Art Unit: 3641

Application No.: 10/509,518

Examiner: S. JOHNSON

Filed: November 26, 2004

Docket No.: 121230

For: INITIATOR

RESPONSE TO ELECTION OF SPECIES REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the November 28, 2006 Election of Species Requirements, Applicants provisionally elect Species C, Fig. 4, with traverse. Applicants respectfully assert that at least claims 34-39, 43 and 44 read on Species C and at least claim 34 is generic to all species.

Applicants' respectfully submit that there exists *a priori* unity of invention with respect to all of the identified species, by virtue of the fact that claim 34 is generic to all species. Applicant's also respectfully submit that there exists *a priori* unity of invention with respect to claims 35-47, by virtue of the fact that claims 35-47 variously depend from claim 34. As stated in Chapter 10.6 of the ISPE (*International Search and Preliminary Examination Guidelines*):

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (Rule 6.4).

Therefore, each dependent claim shares at least each element or technical feature of independent claim 34. ISPE 10.7 further provides:

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention.

Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claim are known. *See* ISPE 10.7 and 10.8.

The Office Action does not establish that each and every element of independent claim 34 is known in the prior art.

Page 3, paragraph 4, of the Office Action states "In order to qualify as a special technical feature, it must be established that this feature makes the claim patentable." For the reasons discussed above, this analysis is not correct because it is the Examiner that must first establish that all of the elements of independent claim 34 are known before asserting the Election of Species Requirement. The Examiner's analysis also contradicts the MPEP. As explicitly stated in MPEP 1893.03(d), the Examiner must (1) list the different species and (2) explain why each species lacks unity with each other species (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each species. (2) was clearly not satisfied as admitted in paragraph 4 of the Office Action.

Therefore, Applicants respectfully submit that lack of unity of invention has not been established, and thus an election of species requirement at this time is improper.

Respectfully submitted,



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